

## PATENT

**REMARKS:**

At the time of the Office Action, claims 1-20 were pending and considered by the Examiner. Claim 3 stands allowed, and claims 9 and 14-20 stand objected to. Claims 5, 6, 11 and 12 have been withdrawn. Claims 1, 2, 4, 7, 8, 10 and 13 stand rejected. Pursuant to this Amendment, claim 1 has been amended. Claims 1-20 remain pending in the subject application.

Allowance of claim 3 is noted with thanks.

The Examiner has indicated that claims 14-20 would be allowable if rewritten in independent form. However, claims 14 and 20 are already written in independent form, and claims 15-19 depend from claim 14. Thus, is it respectfully argued that claims 14-20 are in condition for allowance. Clarification as to the status of claims 14-20 is respectfully requested.

Claims 5, 6, 11 and 12 have been withdrawn as being directed to a nonelected species. Upon allowance of a generic claim, these dependent claims shall be given consideration. Since generic claim 1 is allowable as argued below, these claims are also allowable for at least the same reasons applied thereto, as well as for the additional subject matter recited in each.

Claims 1, 2 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Grapes et al. (U.S. Patent No. 4,867,235). Claims 1 and 7 stand rejected under 35 U.S.C. 102(e) as being anticipated by Houle et al. (U.S. Patent No. 6,837,306). Claim 4 stands rejected under 35 U.S.C. 102(b) as being anticipated by Hyman et al. (U.S. Patent No. 5,467,814). Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Houle et al. in view of Grapes et al. Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Houle et al. in view of Hyman et al. These rejections are traversed for at least the following reasons.

In response to the Amendment submitted on May 15, 2006, the Examiner opines that claim 1 fails to distinguish over the prior art because the manner of operating the device does not differentiate the claim from the prior art. The Examiner points to MPEP 2114 for his reasoning. However, in the case law cited under MPEP 2114, it is noted that the absence of a disclosure in a prior art reference relating to function does not defeat a finding of anticipation if the functional

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limitation at issue is inherent in the prior art reference. Contrary to this reasoning, the functional limitation in claim 1 ("for transferring heat along said fibers from the hotter areas to the colder areas as an associated device moves past said contact surface") is not inherent in either Grapes et al. or Houle et al. As previously argued, Grapes et al. teach that heat enters the thermal plane whenever the electronic components are mounted upon the printed circuit board. Similarly, Houle et al. do not teach a heat-equalizing device that transfers heat along the fibers from the hotter areas to the colder areas as an associated device moves past the contact surface. In other words, the functional limitation for transferring heat along the fibers from the hotter areas to the colder areas as an associated device moves past the contact surface is not inherent in the cited references. For at least these reasons, claim 1 is not anticipated by Grapes et al. or Houle et al.

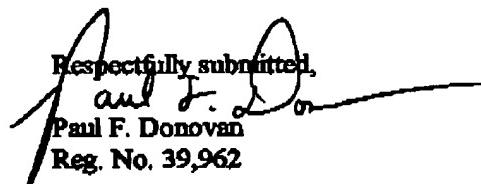
Even so, in an attempt to advance the prosecution of the subject application, claim 1 has been amended to more clearly recite that the contact surface is adapted for transferring heat along the fibers from the hotter areas to the colder areas as an associated device moves past the contact surface. MPEP 2111.04 provides that when an "adapted for" clause is material to patentability, it cannot be ignored in order to change the substance of the invention. In regards to claim 1 of the subject application, the contact surface is claimed as being adapted for transferring heat along the fibers from the hotter areas to the colder areas as an associated device moves past the contact surface. This functional limitation is material to the scope of claim 1. In other words, a contact surface in the prior art that does not transfer heat along fibers from the hotter areas to the colder areas as an associated device moves past the contact surface would not read on the recited limitation. Since neither Grapes et al. nor Houle et al. provide the recited functional limitation taken together with the structural elements of the contact surface, claim 1 is not anticipated by either Grapes et al. or Houle et al.

Claims 2 and 4-13 depend from claim 1, and, therefore, are allowable for the same reasons applied thereto, as well as for the additional subject matter recited in each.

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No new matter has been added by way of the amendments and remarks made herein. Reconsideration and allowance of all the pending claims are respectfully requested. In the event that there are any issues that can be expeditiously handled by telephone conference, the Examiner is invited to telephone the undersigned at the number indicated below.

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